



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nora Femenia et al.

Examiner: Pierre Elisca

Serial No.: 09/711,578

Group Art Unit: 3621

Filed: November 13, 2000

Docket: 2043.003US1

AUTOMATED CROSS-CULTURAL CONFLICT MANAGEMENT

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**APPEAL BRIEF UNDER 37 CFR § 41.37**

Mail Stop Appeal Brief- Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on March 10, 2006, and the Notice of Panel Decision on Pre-Appeal Brief Review mailed May 3, 2006, from the Final Rejection of claims 1-8, 10-18 and 20 of the above-identified application, as set forth in the Final Office Action mailed on January 10, 2006.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of \$500.00 which represents the requisite fee set forth in 37 C.F.R. § 41.2(b)(2). Appellants respectfully request consideration and reversal of the Examiner's rejections of pending claims.

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**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

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## **1. REAL PARTY IN INTEREST**

The real party in interest of the above-captioned patent application is the assignee,  
EBAY INC.

## **2. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to Appellants that will have a bearing on the Board's decision in the present appeal.

### **3. STATUS OF THE CLAIMS**

The present application was filed on November 13, 2000 with claims 1-20. A non-final Office Action was mailed July 15, 2005. A Final Office Action (hereinafter “the Final Office Action”) was mailed January 10, 2006. Claims 1-8, 10-18 and 20 stand twice rejected, remain pending, and are the subject of the present Appeal. Claims 9 and 19 were objected to as being dependent upon a rejected base claim, but were otherwise allowable.

#### **4. STATUS OF AMENDMENTS**

No amendments have been made subsequent to the Final Office Action dated  
January 10, 2006

## **5. SUMMARY OF CLAIMED SUBJECT MATTER**

The pending claims generally recite management of a dispute about a pre-existing agreement, comprising automatically receiving information relating to the dispute from one of an initiator and a respondent (*see, e.g.* Fig. 2, 105; Fig. 3, 205), the initiator and the respondent being parties to the agreement (p. 3, ln.4-10; p. 4 ln. 6-8 and 16-21)), and iteratively providing portions of the information to the other of the initiator and the respondent (*see, e.g.* the flowcharts of Figs. 2 and 3) in accordance with predetermined criteria relating to either a rating of a portion of the information supplied after a start of the dispute by the initiator or the respondent (*see, e.g.* Fig. 2, 120; Fig. 3, 315; p. 5, ln. 11-20), or relating to the number of portions of the information to be provided at an iteration (p. 6, ln. 5-6; p. 14, ln. 3-5).

## **6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

I. Claims 1-8, 10-18 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tavor et al. (U.S. 6,553,347) in view of D'Alessandro (U.S. 6,556,974).



## **7. ARGUMENT**

### **I. Whether claims 1-8, 10-18 and 20 are allowable under 35 U.S.C. § 103(a) over Tavor et al. (U.S. 6,553,347) in view of D'Alessandro (U.S. 6,556,974).**

To maintain a proper rejection under 35 U.S.C. §103(a), The references when properly combined must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

Tavor discusses an automatic virtual negotiation system in which price, terms of sale, and other criteria are considered in negotiating a potential purchase of a product. The claims and specification of Tavor address various functions such as setting an offer price, agreeing to purchase at an offered price, offering a discount incentive, and other such elements of pre-purchase negotiation, but do not consider resolution of disputes regarding an agreement that has already been reached.

The Office Action fails to allege with any specificity that Tavor anticipates a pre-existing agreement, but simply broadly states that Tavor contemplates pre-existing agreements and related elements while citing text relating to discussing terms of a sale. Tavor is relied upon in the office actions, including in the final office action at p. 5, lines 5-9, to anticipate this element of the pending claims. The office action there alleges that Tavor's exchange of price quotes, discounts, and counter-offers is the same as a dispute regarding a pre-existing agreement. While arguing over price may be considered a dispute of sorts, negotiating terms of a sale as is disclosed in Tavor does not relate to resolving a pre-existing agreement as is recited in the pending claims, but is an attempt to establish an agreement between parties where an agreement as to terms of a potential sale does not yet exist. Closer inspection of Tavor indicates that in addition to failing to

consider managing or resolving a dispute regarding a preexisting agreement, the reference fails to discuss receiving information from parties to a dispute regarding a pre-existing agreement. Tavor also fails to consider iteratively providing portions of information supplied after a start of a dispute where the dispute is about a pre-existing agreement, but considers only pre-sale price negotiation in the absence of a preexisting agreement or dispute regarding such an agreement.

Further, the specification of the pending application clearly indicates on p. 15, ln 12-14, that the examples provided regarding resolution of a preexisting agreement are distinct from pre-contract negotiations, which are described as a different potential application of the methods described.

Because several elements of the pending claims relating to resolution of a dispute regarding a preexisting agreement are not found in Tavor, the Tavor reference cannot be used to anticipate these elements of the pending claims. To sustain a valid 35 U.S.C. §103 rejection, the references when combined must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Here, neither reference discusses resolution of a dispute regarding a preexisting arrangement. Further, neither reference discusses receiving information from parties to a dispute regarding a preexisting agreement, or iteratively providing portions of information supplied after a start of a dispute where the dispute is about a pre-existing agreement, as are recited in the pending claims. Because the references when combined fail to teach most elements of the pending claims, the claims are believed to be in condition for allowance.

D'Alessandro discusses a different technology involving collecting data to provide an assessment of an organization's performance. More specifically, the answers to survey questions are gathered to evaluate a plurality of predetermined criteria relating to performance of an organization (*see, e.g.*, col. 2, ln. 65-67).

D'Alessandro fails to discuss managing or resolving a dispute, including those regarding a preexisting agreement. It further also fails to discuss receiving information from parties to a dispute regarding a preexisting agreement, but contemplates only collecting survey data regarding an organization's performance. D'Alessandro further

fails to consider iteratively providing portions of information supplied after a start of a dispute where the dispute is about a pre-existing agreement, as is recited in the pending claims.

Because Tavor and D'Alessandro are unrelated and do not provide suggestion or motivation for combination with one another, combination of the two cited references in an attempt to anticipate the pending claims is also improper. The Tavor and D'Alessandro references cited here use very different methods to achieve very different purposes, and neither reference considers combination with the other as would be required to sustain a 35 U.S.C. § 103 rejection. Further, even if the references were properly combinable, the fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990)); *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

In conclusion, several elements of the pending claims, including all elements relating to a re-existing agreement or information or actions related to a pre-existing agreement, are not present in either cited reference. Further, no proper motivation for combination of the references has been shown, and the piecemeal combination of elements from the references absent showing of motivation for combination is improper. Reversal of the rejection to the pending claims 1-8, 10-18, and 20 is therefore respectfully requested.

## 8. SUMMARY

It is respectfully submitted that the art cited does not render the claim anticipated and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claims are therefore respectfully requested.

Respectfully submitted,

NORA FEMENIA et al.

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Date Aug 3 06 By [Signature]  
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 3 day of August, 2006.

Name Peter Rubiconi Signature [Signature]

## **CLAIMS APPENDIX**

1. (Rejected) A method of managing a dispute about a pre-existing agreement, comprising:  
automatically receiving information relating to the dispute from one of an initiator and a respondent, the initiator and the respondent being parties to the agreement, and  
iteratively providing portions of the information to the other of the initiator and the respondent in accordance with predetermined criteria relating to either a rating of a portion of the information supplied after a start of the dispute by the initiator or the respondent, or relating to the number of portions of the information to be provided at an iteration.
2. (Rejected) The method of claim 1, further comprising automatically retrieving information relating to the community of the other of the initiator and the respondent.
3. (Rejected) The method of claim 1, wherein the received information includes at least one factor and an evaluation of the desirability or cost of the factor.
4. (Rejected) The method of claim 3, wherein the at least one factor includes at least two of historical harm, future harm, an incentive, a punishment, a request, an offer, and a desired outcome.
5. (Rejected) The method of claim 1, further comprising iteratively receiving factors relating to the dispute from the other of the initiator and the respondent.
6. (Rejected) The method of claim 1, further comprising iteratively receiving evaluations of the desirability or cost of the portions of iteratively provided information from the other of the initiator and the respondent.

7. (Rejected) The method of claim 1, further comprising automatically proposing an agreement to resolve the dispute based on the received information.

8. (Rejected) The method of claim 7, wherein the agreement is automatically proposed in accordance with factors relating to the dispute received from the other of the initiator and the respondent.

9. (Objected To) The method of claim 8, wherein the agreement is automatically proposed in accordance with an evaluation of desirability from the initiator or the respondent and an evaluation of cost from the other of the initiator or the respondent, the evaluations being associated with the same portion of the dispute related information or the same dispute related factor.

10. (Rejected) The method of claim 1, further comprising automatically providing advice to the other of the initiator and the respondent based on iteratively provided information.

11. (Rejected) An apparatus for managing a dispute about a pre-existing agreement, comprising:

a computer for automatically receiving information relating to the dispute from one of an initiator and a respondent, the initiator and the respondent being parties to the agreement, and for iteratively providing portions of the information to the other of the initiator and the respondent in accordance with predetermined criteria relating to either a rating of a portion of the information supplied after a start of the dispute by the initiator or the respondent, or relating to the number of portions of the information to be provided at an iteration.

12. (Rejected) The apparatus of claim 11, wherein the computer is also for automatically retrieving information relating to the community of the other of the initiator and the respondent.

13. (Rejected) The apparatus of claim 11, wherein the received information includes at least one factor and an evaluation of the desirability or cost of the factor.
14. (Rejected) The apparatus of claim 13, wherein the at least one factor includes at least two of historical harm, future harm, an incentive, a punishment, a request, an offer, and a desired outcome.
15. (Rejected) The apparatus of claim 11, wherein the computer is also for iteratively receiving factors relating to the dispute from the other of the initiator and the respondent.
16. (Rejected) The apparatus of claim 11, wherein the computer is also for iteratively receiving evaluations of the desirability or cost of the portions of iteratively provided information from the other of the initiator and the respondent.
17. (Rejected) The apparatus of claim 11, wherein the computer is also for automatically proposing an agreement to resolve the dispute based on the received information.
18. (Rejected) The apparatus of claim 17, wherein the agreement is automatically proposed in accordance with factors relating to the dispute received from the other of the initiator and the respondent.
19. (Objected To) The apparatus of claim 18, wherein the agreement is automatically proposed in accordance with an evaluation of desirability from the initiator or the respondent and an evaluation of cost from the other of the initiator or the respondent, the evaluations being associated with the same portion of the dispute related information or the same dispute related factor.

20. (Rejected) The apparatus of claim 11, wherein the computer is also for automatically providing advice to the other of the initiator and the respondent based on iteratively provided information.



## **EVIDENCE APPENDIX**

None.

**RELATED PROCEEDINGS APPENDIX**

None.